

Application No. 10/644813
Amendment dated 9 January 2006
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REMARKS

Prior to this paper, claims 1-38 were pending. In this paper, the Applicant has:

- amended claims 4, 8, 12, 17, 20, 23, 26, 28, 30, 34; and
- cancelled claims 1-3, 32, 33 and 38.

These amendments are submitted to be supported by the application as originally filed and to add no new matter.

Claims 4-31 and 34-37 are pending after this amendment.

Claims 35-37

The Examiner has indicated in paragraph 4 of the Office Action that claims 35-37 are allowed.

Claims 4-11 and 20-22

The Examiner has indicated that claims 4-11 and 20-22 contain allowable subject matter and would be allowed if rewritten in independent form to include all of the features of their respective base claims and any intervening claims. The Applicant has done this by:

- amending claim 4 to incorporate the features of claims 1 and 3;
- amending claim 8 to incorporate the features of claims 1 and 2; and
- amending claim 20 to incorporate the features of claims 1, 12 and 13.

Claims 4, 8 and 20 are therefore submitted to be allowable. Claims 5-7 depend from claim 4; claims 9-11 depend from claim 8 and claims 21-22 depend from claim 20. Accordingly, the Applicant submits that claims 5-7, 9-11 and 21-22 are also in condition for allowance.

Claims 23, 24 and 28-31

The Office Action raises US patent No. 5,417,323 (Presnick) and US patent No. 6,644,482 (Ku) in connection with claims 23, 24 and 28-31 under 35 USC § 103. The Applicant has amended claims 23, 28 and 30 to depend from allowable claim 8 and submits that claims 23, 24 and 28-31 (as amended) are allowable over the combination of Presnick and Ku.

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As discussed above, the Applicant has amended claim 8 to be in condition for allowance. Claims 23, 24 and 28-31 (as amended) depend from claim 8 and are submitted to be allowable for at least this reason.

Claims 17, 18, 25-27 and 34

As originally presented, claims 17, 18, 25-27 and 34 were drawn to non-elected species. In this paper, the Applicant has amended these claims to depend from allowable base claim 8, which is submitted to be generic to the species represented by claims 17, 18, 25-27 and 34. Accordingly, the Applicant respectfully requests rejoinder and allowance of claims 17, 18, 25-27 and 34.

As discussed above, the Applicant has amended claim 8 to be in condition for allowance. The Applicant submits that claim 8 is generic to the species represented by claims 17, 18, 25-27 and 34.

The Applicant has amended claim 17 to depend from allowable and generic claim 8 and to incorporate the features of claims 12 and 14. The Applicant submits that claim 17 and claim 18 (which depends from claim 17) are now in condition for allowance.

Claim 25 depends from claim 23. As discussed above, the Applicant has amended claim 23 to depend from allowable and generic claim 8. Accordingly, the Applicant submits that claim 25 is in condition for allowance.

The Applicant has amended claim 34 to depend from allowable and generic claim 8 and submits that claim 34 is now in condition for allowance.

Based on this reasoning, the Applicant respectfully requests rejoinder and allowance of claims 17, 18, 25-27 and 34.

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Claims 12-16 and 19

The Office Action has rejected claims 12-16 and 19 under 35 USC § 103 in light of the combination of Presnick, Ku and US patent No. 5,848,688 (Paloheimo).

The Applicant has amended claim 12 to put it in independent form by incorporating the features of its base claim (claim 1). Claim 12 is otherwise not amended. The Applicant thanks the Examiner for her indication in the 3 January 2006 telephone conference with the Applicant's agent that she would reconsider the rejection of claim 12.

The Applicant submits claims 12-16 and 19 recite allowable subject matter and that the rejection of claims 12-16 and 19 in the Office Action was improper.

Paragraph 4 of the Office Action makes the following statements in relation to claims 12-16 and 19.

Claims 12-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references [Presnick and Ku] as applied to claims 1,-2 above, and in further view of Paloheimo (5,848,688). Presnick '323 as modified above discloses all of the limitations of the claims except for the specifics of the pivot joint. Paloheimo '688 discloses a pivot joint define [sic] at least a portion of an inwardly extending channel which leads toward the pivot joint and terminates in a bore located within the pivot joint. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pivot joint of Presnick '323 with a channel and bore as taught by Paloheimo '688 for a tighter pivot joint connection.

With respect to the shape of the channel, bore, finger and the container base and lid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify these shapes since such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In Re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 12 recites features including:

- "a semi-annular lid member which extends in a direction parallel to the pivot axis";
- "a semi-annular base member that extends in a direction parallel to the pivot axis";
- and
- "the semi-annular lid and base members slidably coupled to one another to enable pivotal movement of the lid relative to the base about the pivot axis".

All of claims 13-16 and 19 depend from claim 12.

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Presnick, Ku and Paloheimo fail to disclose these features in the context of claim 12. The Office Action makes no reference to these features in the rejection of claim 12 and therefore fails to provide a *prima facie* case that claim 12 is obvious within the meaning of 35 U.S.C. § 103. Accordingly, the Applicant respectfully submits that the Office Action's rejection of claims 12-16 and 19 was improper.

The Applicant submits further that claim 12 patentably distinguishes the combination of Presnick, Ku and Paloheimo. As correctly pointed out by the Examiner at paragraph 4 of the Office Action, Presnick does not disclose the specifics of the pivot joint recited in claim 12. Ku does not disclose any pivot joint and therefore Ku also fails to disclose the features of the pivot joint recited in claim 12. The Applicant submits that Paloheimo fails to remedy this deficiency.

As understood, Paloheimo discloses "sleeve-type" disc covers, where each cover has a lid (1) rigidly mounted to a base (2) via side surface (3) and each sleeve-type cover has a cover opening (4) for inserting and removing a disc from the cover. Paloheimo discloses a pivot joint (6) which allows pivotal motion between individual covers. Paloheimo fails to disclose or suggest a pivot joint that facilitates pivotal motion between the base and the lid of an individual cover. More particularly, Paloheimo fails to disclose or suggest the claim 12 combination of a "semi-annular lid member ... and a semi-annular base member ... the semi-annular lid and base members slidably coupled to one another to enable pivotal movement of the lid relative to the base about the pivot axis". There would be no motivation to modify the Paloheimo pivot joint (6) to provide such a feature, since discs are inserted and/or removed from the Paloheimo cover via opening (4) in side surface (3).

Based on this reasoning, the Applicant respectfully submits that claim 12 patentably distinguishes the combination of Presnick, Ku and Paloheimo. Therefore, the Applicant respectfully requests allowance of claim 12 and claims 13-16 and 19 which depend from claim 12.

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Conclusions

In view of the amendments and comments presented above, the Applicant submits that all claims are in condition for allowance and respectfully requests reconsideration and allowance of this application. If there are any remaining issues preventing the allowance of pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,
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